

**REMARKS:**

Claims 1-35 are currently pending in the Application. Claims 1-35 stand rejected under 35 § U.S.C. 102(e) as being anticipated by Herz et al. (U.S. Patent Application Publication No. 2001/0014868 to Herz et al., hereinafter referred to as "Herz").

The Examiner states that the Applicant's submission filed on 17 January 2006 has been entered. The Applicant points out that the submission filed on 17 January 2006 to which the Examiner refers included amendments to claims 1, 12, 23, 34, and 35. However, the Office Action mailed 28 April 2006 contains references to claim language of claim 1 in the form prior to the amendments to claim 1 which were made in the submission filed on 17 January 2006. More specifically, at the first full paragraph of page 5 of the Office Action mailed 28 April 2006, the Examiner refers to "providing at least some of the recorded query information, presentation information or selection information to the particular seller to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers." However, as amended by the 17 January 2006 submission, that portion of claim 1 now reads "providing the recorded query information and at least one of the presentation information and the selection information to the particular seller to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers." For the sake of clarity, a complete listing of the claims is included in this submission.

**REJECTION UNDER 35 U.S.C. § 102:**

Claims 1-35 stand rejected under 35 § U.S.C. 102(e) as being anticipated by Herz. However, because Herz fails to disclose all of the limitations of claims 1-35, Herz cannot anticipate claims 1-35.

This rejection is respectfully traversed.

**Herz Fails to Disclose All of the Limitations Recited in Applicant's Claims**

For example, with respect to independent claim 1, this claim recites:

An electronic commerce system that provides market feedback to sellers, comprising:

one or more memory units storing program instructions for:

recording query information associated with a search query of one or more databases containing product data, the search query involving a search by a buyer;

recording presentation information associated with the manner in which a plurality of search results are presented to the buyer, each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller;

recording selection information associated with selection by the buyer of a particular search result from among the plurality of search results, the particular search result comprising data for a particular product matching one or more search criteria specified in the search query; and

providing the recorded query information and at least one of the *presentation information* and the *selection information* to the particular seller ***to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers***; and

one or more processing units that execute the stored program instructions to:

record query information associated with a search query for a buyer of one or more databases containing product data;

record presentation information associated with the manner in which a plurality of search results are presented to the buyer, each search result comprising data for a product matching one or more search criteria specified in the search query, the search results comprising one or more search results reflecting product data for a particular seller;

record selection information associated with selection by the buyer of a particular search result from among the plurality of search results,

the particular search result comprising data for a particular product matching one or more search criteria specified in the search query; and

provide the recorded query information and at least one of the ***presentation information*** and the ***selection information*** to the particular seller ***to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers.*** (Emphasis added).

Independent claims 12, 23, 34, and 35 recite similar limitations. Herz simply fails to disclose, teach, or suggest each and every element of independent claims 1, 12, 23, 34, and 35.

Herz discloses a system for automatically customizing prices and promotions offered to shoppers for the purpose of maximizing vendor profits (Abstract, lines 1-4). The offers are communicated either to the vendor, who may act on them as desired, or to an on-line computer shopping system that can directly make such offers to shoppers (paragraph 004 lines 7-10). In the case of using computers to aid in the decision of what offers are made to shoppers, "shopper profiles" are created based on shopper attributes (paragraph 0019 lines 21-22). After consideration of a number of factors, the computer system generates an "offer profile" based on offer attributes (paragraph 0019 lines 20-21). When the Herz system is used for on-line shopping, the Herz system typically undertakes the following steps: (1) profiling a shopper based on either solicited information, demographic information related to the shopper, or information collected about the shopper during shopping (paragraphs 0029-0034), (2) determining the identity of the shopper through an identification procedure so that the shopper's profile can be accessed in the shopper database (paragraph 0035), (3) determining the shopper's shopping goals through shopper inputs (paragraph 0036), (4) automatically selecting offers from an offer database based on a number of criteria typically related to the shopper's profile (paragraph 0037), (5) presenting the selected offers to the shopper (paragraph 0038), and (6) updating the shopper's profile with active or passive shopper feedback gathered during the shopping process (paragraph 0039). The Herz system essentially uses shopper profiles to

automatically select offers most likely to be accepted by the shopper (according to the Herz system calculations) from an offer database and to present those offers to the shopper.

While the Herz system is primarily concerned with updating and using shopper profiles for presenting offers to shoppers during the shopping process, the present invention is concerned with presenting information gathered during the shopping process to the seller after the shopping process has completed so that sellers may better gauge the market impact of their offerings, their product data and seller data, and other aspects of their business (page 22 lines 4-7). Further, while the Herz system is concerned with matching shoppers with suitable offers from a *single vendor*, the present invention is related to a system which presents the offers of *multiple vendors to a single shopper* in an effort to reduce multiple one-to-one searches (one buyer to one seller) by searching the multiple vendors' offerings at a single web site (page 7 lines 13-22). In essence, the Herz system is concerned with *optimizing offers from a single vendor to a particular shopper* while the present invention is concerned with providing a seller information on how the seller can adjust the seller's offer (or other advertised data) so as *to attract a shopper to the seller's offer rather than to the offer of a competing seller*.

The Applicant respectfully submits that Herz has nothing to do with independent claim 1 limitations regarding "providing the recorded query information and at least one of the presentation information and the selection information to the particular seller *to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers*." The Examiner asserts, at page 5 of the Office Action mailed 28 April 2006, that Herz teaches "...allow[ing] the particular seller to assess one or more aspects of its product data relative to data of other sellers" based on the discussion of a "virtual mall" search interface layout discussed at paragraph 0260 of Herz. The Applicant respectfully points out that the Examiner has misunderstood the context of the "virtual mall" discussion in Herz.

The discussions in Herz are conveniently divided into sections denoted by subtitles such as "Problem" found between paragraphs 0002 and 0003 and "Solution" found between paragraphs 0003 and 0004. It is important to note that the "virtual mall"

discussion (relied upon by the Examiner to show that Herz discloses the use of the Herz offer optimization system in an environment with multiple merchants) is clearly located under a section subtitled "Shopper Browsing of Offers" located between paragraphs 0251 and 0252. The content of the "Shopper Browsing of Offers" section encompasses paragraphs 0252-0260. In short, the "Shopper Browsing of Offers" section describes various means for presenting "useful organization on the collection of offers available for browsing by a shopper." (paragraph 0252 lines 16-17).

The various means of presenting offers to shoppers include a "hierarchical cluster tree" approach and associated "menus" (paragraph 0252) through which the shopper experiences "clusters" and "subclusters" represented visually as a store shelf where "related products are displayed near each other; [where] the display may use graphics so that similar products appear to sit on the same "shelf"." (paragraph 0255 lines 18-20). In another variation of browser interfaces for use by a shopper, Herz discloses "lateral navigation between clusters at level n as well as choosing them from the menus of cluster at level n+1...the effect is one of a "virtual mall" in which related departments are linked." (paragraph 0259 lines 59-65). Herz then comments that "merchants might pay for better shelf space in electronic shopping malls, just as they pay for advertising...in off-line bookstores and supermarkets." (paragraph 0260 lines 1-3). Finally, the browsing environment discussion of Herz is closed with the comment that "it is possible to represent the entire navigable search space of the World Wide Web...with a walk through virtual village..." (paragraph 0260 lines 26-32).

This mere sweeping comment about the hypothetical possibility of integrating the entire contents of the internet into a navigable browsing environment cannot alone support the assertion made by the Examiner that Herz discloses use of the offer optimization system with multiple merchants. Further, it is also very important to note that in the order of events, "shopper browsing of offers" takes place during the fifth step ("presenting the selected offers to the shopper" (paragraph 0038)) of the Herz system functions. As there is no discussion of multiple merchants during the fourth step of "automatically selecting offers from an offer database based on a number of criteria typically related to the shopper's profile" (paragraph 0037), Herz cannot be held to teach performing the offer optimization process as related to multiple merchants.

The Examiner further asserts at page 5 of the Office Action mailed 28 April 2006 that since vendors may share their shopper databases, which contain shopper profiles, that the sharing of shopper databases inherently would allow the vendors to assess the aspects of their products relative to other vendors. The Examiner asserts that based upon the shopper database sharing, the vendors would know “how shoppers react to the presentation.” The Applicant respectfully points out that knowing “how shoppers react to the presentation” simply does not anticipate allowing “**the particular seller to assess one or more aspects of its product data relative to product data of other sellers**” as required by claim 1. The Applicant respectfully submits that these distinctions alone are sufficient to patentably distinguish independent claim 1 from Herz.

The Applicant further respectfully submits that Herz has nothing to do with independent claim 1 limitations regarding “providing the recorded query information and at least one of the **presentation information** and the **selection information** to the particular seller...” The Applicant points out that **presentation information** may include the actual order of display of the search results (which contains offers from multiple vendors/sellers) or sort criteria used to sort the results for presentation in a desired order of display (page 22 line 31 to page 23 line 10). Similarly, **selection information** is related to the buyer selecting a particular search result from among multiple search results (offers from different vendors/sellers) (page 3 lines 11-13). Clearly, the “**at least one of the presentation information and the selection information**” must include some data complementary to and capable of enabling the claim 1 limitation that the provision of the **presentation information and the selection information** be used “**to allow the particular seller to assess one or more aspects of its product data relative to product data of other sellers.**” Since Herz does not teach providing search results from multiple vendors/sellers (as described above), the provision of information to a seller as taught by Herz cannot teach the provision of **presentation information and the selection information** as required by claim 1 of the present invention. The Applicant respectfully submits that these distinctions alone are sufficient to patentably distinguish independent claim 1 from Herz.

Claims 12, 23, 34, and 35, include limitations similar to the limitations of claim 1 discussed above. Therefore, the discussion above in connection with claim 1 applies equally to claims 12, 23, 34, and 35, as well as the claims depending from claims 1, 12, 23, 34, and 35

Accordingly, it is respectfully submitted that claims 1-35 are in condition for allowance, and notice to that effect is respectfully requested.

**THE LEGAL STANDARD FOR ANTICIPATION REJECTIONS UNDER 35 U.S.C. § 102:**

The following sets forth the legal standards for "anticipation."

The events that can lead to anticipation can be divided into the following seven categories, all defined by statute:

1. Prior Knowledge: The invention was publicly known in the United States before the patentee invented it.
2. Prior Use: The invention was publicly used in the United States either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
3. Prior Publication: The invention was described in a printed publication anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his patent application.
4. Prior Patent: The invention was patented in another patent anywhere in the world either (i) before the patentee invented it; or (ii) more than one year before he filed his application.
5. On Sale: The invention was on sale in the United States more than one year before the patentee filed his application.

6. Prior Invention: The invention was invented by another person in the United States before the patentee invented it, and that other person did not abandon, suppress or conceal the invention.

7. Prior U.S. Patent: The invention was described in a patent granted on a patent application filed in the United States before the patentee made the invention.

Each of those seven events has its own particular requirements, but they all have the following requirements in common:

1. Anticipation must be shown by clear and convincing evidence.
2. If one prior art reference completely embodies the same process or product as any claim, the product or process of that claim is anticipated by the prior art, and that claim is invalid. To decide whether anticipation exists, one must consider each of the elements recited in the claim and determine whether all of them are found in the particular item alleged to be anticipating prior art.
3. There is no anticipation unless every one of those elements is found in a *single* prior publication, prior public use, prior invention, prior patent, prior knowledge or prior sale. One may not combine two or more items of prior art to make out an anticipation. One should, however, take into consideration, not only what is expressly disclosed or embodied in the particular item of prior art, but also what inherently occurred in its practice.
4. There cannot be an accidental or unrecognized anticipation. A prior duplication of the claimed invention that was accidental, or unrecognized, unappreciated, and incidental to some other purpose is not an invalidating anticipation.

Those four requirements must be kept in mind and applied to each kind of anticipation in issue. The following additional requirements apply to some categories of anticipation.



1. Prior Knowledge: An invention is anticipated if it was known by others in the United States before it was invented by the patentee. "Known," in this context, means known to the public. Private knowledge, secret knowledge or knowledge confined to a small, limited group is not necessarily an invalidating anticipation. Things that were known to the public only outside the United States are not invalidating anticipation.

2. Prior Use: An invention is anticipated if it was used by others before it was invented by the patentee, or more than one year before the patentee filed his patent application. "Use," in this context, means a public use.

3. Prior Publication: A patent is invalid if the invention defined by the claims was described in a printed publication before it was invented by the patentee or more than one year prior to the filing date of his application. For a publication to constitute an anticipation of an invention, it must be capable, when taken in conjunction with the knowledge of people of ordinary skill in the art, of placing the invention in the possession of the reader. The disclosure must be enabling and meaningful. In determining whether the disclosure is complete, enabling, and meaningful, one should take into account what would have been within the knowledge of a person of ordinary skill in the art at the time, and one may consider other publications that shed light on the knowledge such a person would have had.

4. Prior Patent: If the invention defined by the claims was patented in the United States or a foreign country, either before it was invented by the inventor or more than one year before the inventor filed his patent application, then the invention was anticipated. The effective date for this type of anticipation is the date on which two things co-existed: (i) the owner of the referenced patent had the right to enforce that patent; and (ii) the reference patent was available to the public. What was "patented" in the reference patent is determined by what is defined by its claims, interpreted in the light of the general description.

5. On Sale: A patent is invalid if the invention claimed in it was on sale in the United States more than one year prior to the application filing date.

6. Prior Invention: If the invention defined by the claims was invented by another person, in the United States, before it was invented by the inventor, and that other person did not abandon, suppress, or conceal the invention, the invention lacks novelty. A prior invention, even if put in physical form and shown to produce the desired result, is not an invalidating anticipation unless some steps were taken to make it public. However, it is not necessary that the inventor had knowledge of that prior invention.

7. Prior U.S. Application: A patent is invalid for lack of novelty if the invention defined by the claims was described in a United States patent issued on a patent application filed by another person before the invention was made by the inventor. The effective date of a prior application for purposes of this issue is the date on which it was filed in the United States. Foreign-filed patent applications do not apply. If the issued United States patent claims the benefit of more than one United States application, its effective date as an anticipation is the filing date of the first United States application that discloses the invention claimed in that referenced patent.

Experimental Use Exception: The law recognizes that it is beneficial to permit the inventor the time and opportunity to develop his invention. As such there is an "experimental use" exception to the "public use" and "on sale" rules. Even though the invention was publicly used or on sale, more than one year prior to the application filing date, that does not invalidate the patent, provided the principal purpose was experimentation rather than commercial benefit. If the primary purpose was experimental, it does not matter that the public used the invention or that the inventor incidentally derived profit from it.

When a public use or sale is shown, the burden is on the inventor to come forward with evidence to support the experimental use exception. Only experimentation by or under the control of the inventor qualifies for this exception. Experimentation by a third party, for its own purposes, does not qualify for this exception. Once the invention leaves the inventor's control, its use is a public one, even if further experimentation takes place.

The experimentation must relate to the claimed features of the invention. And it must be for the purpose of technological improvement, not commercial exploitation. If any commercial exploitation does occur, it must be merely incidental to the primary purpose of experimentation. A test done primarily for marketing, and only incidentally for technological improvement, is a public use.

**CONCLUSION:**

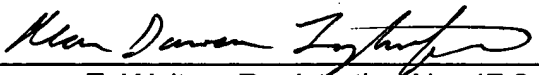
In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

The undersigned hereby authorizes the Director to charge any fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Amendment to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

7/28/2006  
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